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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,119	09/08/2003	Hideki Ueno	ICC-273	7055

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,119

Applicant(s)

UENO ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-7, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moretto et al., U.S. patent # 4,214,066 in view of the review of silicon-based compounds taken from *Kirk-Othmer's Encyclopedia of Chemical Technology, 3rd Edition* and the formula relating viscosity and number of repeat units in *Silicones, An Introduction to their Chemistry and Applications*.

Applicant disputes the validity of the Examiner's combination on the grounds that (i) the relative quantities of polysiloxane-carbodiimide are not disclosed and (ii) the skilled artisan would not have been motivated to look to the teachings of *Kirk-Othmer* insofar as the technologies behind their invention and that of the reference are dissimilar.

Concerning the first matter, Applicant is referred to Example 1 of Moretto wherein it is stated that the dispersion comprises 24% by weight of the polycarbodiimide and 76% of the corresponding siloxane polymer. The claimed composition is one wherein the polycarbodiimide component may comprise anywhere between $0.1/100.1 = .001$ and $200/(100 + 200) = 66.7\%$ by weight of the composition. Clearly, the limitation surrounding the relative amounts of these materials is satisfied by the reference.

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As for the second argument, the Examiner is uncertain as to why Applicant feels that this position is germane to the rejection. First, the motivation to combine need not be for the same reason(s) envisioned by Applicant. Section 2144 of the MPEP addresses this issue. "It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done" (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

Furthermore, *Kirk-Othmer* is cited primarily as an illustration that the alkoxysilicon compounds identified as crosslinking agents in the primary reference are equivalent to component of the present invention. That is, *Kirk-Othmer* was invoked mostly to illustrate that the known alkoxysilane crosslinking agents, which are ubiquitous in condensation-cured polysiloxane systems, contain silicon-carbon bonds and, in that sense, are aptly described as organosilicon compounds. (In retrospect, this may not have even been necessary as *Moretto* draws a clear distinction between alkoxysilicon compounds and tetraalkoxysilanes, which are technically inorganic due to the absence

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of silicon-carbon bonds.) Anyway, the Examiner vehemently disagrees that the skilled artisan would not have been motivated to consult other sources teaching related chemistries, *Kirk-Othmer* being one of perhaps thousands, where the primary teaching failed to provide specific examples of a class of compounds that had been mentioned as having utility in the invention.

To summarize, Moretto actually discloses every aspect of all the incarnations of Applicant's invention disclosed in claims 1-7, 15, and 17 hence even a rejection under 35 U.S.C. § 102 would have been sustainable. *Kirk-Othmer* serves only to corroborate the idea that alkoxysilicon compounds and Applicant's organosilicon compound are equivalent. *Silicones* serves to demonstrate that the polymers reported by *Moretto* inherently possess the viscosity mandated by claim 3.

Allowable Subject Matter

Claims 8-14 and 16 are allowable for the reasons outlined in the previous correspondence. The genus of materials known as "alkoxysilicon compounds" encompasses a huge number of species. The Examiner could not ascertain what would have motivated one of ordinary skill to select amino-functional alkoxysilanes from this immense genus.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 29, 2005


MARGARET G. MOORE
PRIMARY EXAMINER